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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,202	02/02/2001	Harold R. Garner	119929-1028	1495

7590

05/13/2002

Gardere Wynne Sewell LLP
1601 Elm Street, Suite 300
Dallas, TX 75201

EXAMINER

FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 05/13/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,202

Applicant(s)

GARNER, HAROLD R.

Examiner

BJ Forman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 39-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 39-58, drawn to an apparatus for use in synthesis of arrays of DNA probes and polypeptides, classified in class 435, subclass 287.2.
 - II. Claims 59-61, drawn to methods of synthesizing arrays of DNA probes, classified in class 536, subclass 25.3.
 - III. Claims 62-69, drawn to a device for synthesizing multimers, classified in class 422, subclass 68.1.
 - IV. Claims 70-79, drawn to a method for synthesizing multimers, classified in class 536, subclass 25.3 and class 530, subclass 333.
2. The inventions are distinct, each from the other because of the following reasons:
 - a. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product. The apparatus of Invention I can be used to analyze and monitor reactions on the substrate e.g. enzymatic reactions, antibody-antigen binding reactions and chemically stimulated cell reactions. While the preamble of Claim 39 recites the apparatus is "for use in synthesis of DNA probes, polypeptides and the like", the recitation of the intended use for the apparatus does not distinguish the apparatus because an apparatus is distinguished by its structural components. The courts have stated that a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not

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differentiate the claimed apparatus". Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

b. Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product. The apparatus of Invention III can be used to contain cell cultures and detect and/or monitor reactions within the cells. While the preamble of Claim 62 recites the apparatus is "for synthesizing a multimer", the recitation of the intended use for the apparatus does not distinguish the apparatus because an apparatus is distinguished by its structural components.

c. Inventions I and III are independent and distinct apparatus. Inventions are independent and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation and different functions. The apparatus of Invention I operates by integrating a substrate having an active surface and an image former and the apparatus functions to project light onto the substrate. The apparatus of Invention III operates by integrating a chemical reactor and an irradiating optical system and the apparatus functions to irradiate the chemical reactor.

d. Inventions II and IV are independent and distinct methods. Inventions are independent and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operations and different functions. The method of Invention II operates by providing a

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base-containing fluid to an active substrate and the method functions to synthesize two-dimensional arrays of DNA probes. The method of Invention IV operates by adding photogenerated acid precursors to a substrate and irradiating to deblock the precursors and the method functions to synthesize multimers on a substrate.

e. Inventions I and IV are independent and distinct. Inventions are independent and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operations and different functions. The apparatus of Invention I operates by integrating a substrate having an active surface and an image former and the apparatus functions to project light onto the substrate. The method of Invention IV operates by adding photogenerated acid precursors to a substrate and irradiating to deblock the precursors and the method functions to synthesize multimers on a substrate.

f. Inventions II and III are independent and distinct methods. Inventions are independent and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operations and different functions. The method of Invention II operates by providing a base-containing fluid to an active substrate and the method functions to synthesize two-dimensional arrays of DNA probes. The apparatus of Invention III operates by integrating a chemical reactor and an irradiating optical system and the apparatus functions to irradiate the chemical reactor.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

REQUEST FOR INTERFERENCE


5. Applicant's requests for interference pursuant to 37 C.F.R. § 1.604 filed 2 February 2001 and 6 April 2001 are acknowledged. Consideration of these requests will be held in abeyance until the requirements of 37 C.F.R. § 1.608(b) have been met (see MPEP 2801).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


BJ Forman, Ph.D.
Patent Examiner
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May 9, 2002